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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/780,646	02/09/2001	Hubert Dorn	Beiersdorf 9265.5-KGB	1049

7590

01/26/2004

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EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/26/2004

17

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT	PAPER NUMBER
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DATE MAILED: 7/29/03

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 7/29/03

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-15 is/are pending in the application.

Of the above, claim(s) is/are withdrawn from consideration.

☐ Claim(s) is/are allowed.

☒ Claim(s) 10-15 is/are rejected.

☐ Claim(s) is/are objected to.

☐ Claims are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number)

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received:

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s):

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

- SEE OFFICE ACTION ON THE FOLLOWING PAGES -

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The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 10-15 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection of record is maintained. Although the declaration of Hansen shows experimental flea (not the claimed lice) control, it says nothing about systemic absorption and the claim does not provide sufficient limitation for one in the art to know there is no trans membrane, or liking, thus, systemic absorption. Further, the elephant, walrus, cat, dog, cow others are not distinguished from each other, by applicant, and claims include these varied species but no basis for any but dog, cat are evident in the specification to this examiner, besides the fault of no demonstration, or presentation of non-systemic activity and methodology thus, the "wherein clause" is in operatives as the disclosure is fatally flawed, as there is no evident mechanism for one to know systemic efficacy is absent.

Claims 10, 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over EPO285985 - Wolf et al.

The rejection of record is maintained. As interpreted, claim 10 compound III (there is no identification of Z) is disclosed by Wolf as compound I (p.2) to control animal pests, including arthropods, insects (p.11, 2nd paragraph) lice (p.12) fleas (siphonaptera) and IXodes, Psoroptes, Sarooptes (p.14) of dog, cat, beef cattle, fish

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and mice (p.15) by contacting these ectoparasites by drench and dip, pour on, spot on, washing, spraying, powdering, and ear and neck collars (p.16, top). The method is that of the instant method, and only lacks anticipation for failure to differentiate the claimed compound from similar compounds; thus, one in the art would select any of the variants of (I) and find them useful to control any of the listed pests of the listed species, at the listed dosages (p.19)..

Applicant's arguments filed 09/29/03 have been fully considered but they are not persuasive. Applicants' arguments are (p.10) to the effect that if the reference teaches dermal, it does not necessarily teach non-systemic, and the EP 0285985 reference teaches all known veterinary application. We find no difference here, and there, as to the systemic or non-systemic activity, except for the wherein-thus, there is no difference in fact, as applicant alleges, but does not show.

The patent office, on the other hand is not equipped to determine trans membrane transfer, modes of animal behavior, and vehicles, adjuvants, and dosages, that may promote or retard systemic activity-applicant must provide the disclosure for one to achieve the claimed whereins.

Claims 10-15 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6232328. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims are those in essence, of the patent.

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Claims 10, 12-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

There is no definition of (Z)-it would appear that the N.H, N-Alkyl can be in addition to whatever Z is.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is 571-272-0619. The examiner can normally be reached on Tuesday- Friday 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9307.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-1235.

Levy/tgd

January 21, 2004



NEIL S. LEVY
PRIMARY EXAMINER